

Docket No. 12969-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler et al

Group Art Unit: 1714

5 Serial No.: 09/810,920

Examiner: Peter Szekely

Filing Date: March 16, 2001

10 Title: Polymeric Thickeners for Oil-containing Compositions
by fax to 1-571-273-1119**Attention; Supervising Examiner Vasu Jaganathan**

Mail Stop AF, Commissioner for Patents

P.O. Box 1450, Alexandria, VA 22313-1450

15 **CORRECTED PAPERS**

As discussed in the telephone conversation on December 11, 2003, between Supervising Examiner Vasu Jaganathan and the undersigned, a Petition and accompanying papers intended for this file were mailed (as first-class mail) to the Office by the undersigned on December 10, 2003. Unfortunately, through error, the Petition and Transmittal Form incorrectly

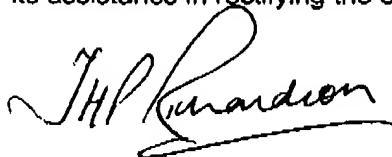
20 reference the parent application, Serial number 09/398,377 (Docket 12969), which is also being examined by Examiner Szekely. The copies attached to the Petition (a previously-filed Petition, a previously-issued Commissioner's Decision, and a previously-filed Reply) are correctly referenced to this file.

As agreed in the telephone conversation, attached hereto are copies of the incorrectly

25 referenced papers showing in manuscript the corrections required so that they refer to this file. Also attached is a copy of page 6 of the Petition showing in manuscript an amendment that the Applicant would like to make. Please insert these amended pages in place of the incorrect originals.

The undersigned regrets the inconvenience caused by this error, and thanks the Office

30 for its assistance in rectifying the error.



Respectfully submitted,

T. H. P. Richardson, Registration No.28,805,

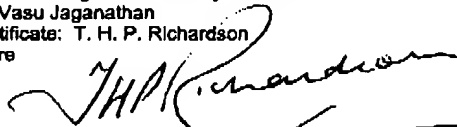
Tel No. 650 854 6304

Certificate of Facsimile Transmission

I hereby certify that this correspondence is being transmitted by facsimile to 571 273 1119 on December 11, 2003, and marked for the attention of Supervising Examiner Vasu Jaganathan

Typed name of person signing this certificate: T. H. P. Richardson

Signature



12969-1

09/810,920

03/16/2001

TRANSMITTAL FORM AND FEE TRANSMITTAL

Attorney Docket No.	12969-1	First Name(s) (Printable)	Bitler
Application No.	09/398,277	Filing Date	09/17/99
Examiner	Szekely P.	Group/Art Unit	1714

This Transmittal Sheet is accompanied by

Petition, check for \$130.00, and an Acknowledgement Postcard

Fee Calculations (Applicant is a small entity)

				Applicable Fee	Fee Paid
(1) Filing fee				740/370	\$
(2) Extra claim fees	No. in Specification or after Amendment	No. Included in Filing Fee or Previously Paid For	No. Extra (b)	Applicable Fee	Fee Paid
Total Claims	32	- 34 =	0	x 18/8	
Ind. Claims	6	- 7 =	0	x 80/40	
Multiple dependent claim(s) presented for first time (c)				No	280/140
				Subtotal (2) Extra claim fees	
(3) Additional or other fees					Fee Paid
Extension for Reply (1,2,3 months: \$110/55, 400/200, 920/460)				month(s)	
Petition to Commissioner (\$130)					130.00
Information Disclosure Statement (\$180)					
				Subtotal (3) Additional or other fees	
Total Fees Submitted (Sum of Subtotals (1), (2), and (3))					130.00

5 A check for \$130.00 is attached**This Sheet is transmitted in duplicate.****Authorization to Charge Deposit Account for Additional Fees**

The Assistant Commissioner for Patents is hereby authorized to charge any additional fees required under 37 CFR §§ 1.16 and 1.17, and credit any overpayments to, the following deposit account.

10

Deposit Account No: 19-2090Deposit Account Name: Sheldon & Mak**CERTIFICATE OF MAILING UNDER 37 CFR****1.8**

I hereby certify that this correspondence is being deposited with United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Mail Stop AF Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

On December 10, 2003 Typed name of person signing this certificate: T. H. P. Richardson

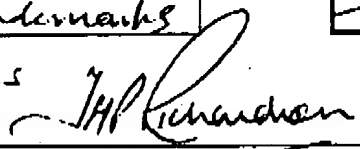
Signature

Respectfully Submitted,

Name T. H. P. Richardson
Tel. No. 650-854-6304 Fax No. 626-795-6321
Sheldon & Mak
225 South Lake Avenue
Pasadena
CA 91101

09/810,920

12969-1

SHELDON & MAK, INC. 225 S. LAKE AVENUE, SUITE 900 PASADENA, CALIFORNIA 91101-3005 (626) 798-4000		EXPLANATION Debit 12969-1 SAC 09/13/03 Return Fee	90-3414/122: 7866
PAY <u>One hundred thirty</u>		DOLLAR CHECK <input checked="" type="checkbox"/>	
DATE <u>12/10/03</u>	TO THE ORDER OF <u>Commissioner of Patents and Trademarks</u>		
<u>Commissioner of Patents and Trademarks</u> 			
CITIZENS BUSINESS BANK 225 E. COLORADO BLVD. PASADENA, CA 91102			
@007866* 1222346491 253243302*			

Bitter coal.

Polymers checkered

Filing Date: 03/16/2001

Attorney: Tim Richardson

09/810,920

12969-1

Serial No.: 09/13/03 377
 Docket No.: 12969
 Date Mailed: 12.10/03

The following has been received in the U.S. Patent Office on the date stamped hereon:

PATENTS: <input checked="" type="checkbox"/> Transmittal Letter <input type="checkbox"/> Utility/Design Patent App. w/ ____ total pages (Includes ____ specification; ____ claims; ____ abstract) <input type="checkbox"/> Drawings w/ ____ sheets <input type="checkbox"/> formal <input type="checkbox"/> informal <input type="checkbox"/> Oath/Declaration <input type="checkbox"/> Power of Attorney <input type="checkbox"/> Small Entity Dec. by a ____ <input type="checkbox"/> Assignment <input type="checkbox"/> IDS w/PTO 1449 and References <input type="checkbox"/> Response to Missing Parts <input type="checkbox"/> Petition for Extension of Time <input type="checkbox"/> Amendment/Response <input type="checkbox"/> Issue Fee Transmittal <input type="checkbox"/> PCT Application	<input type="checkbox"/> Chapter II Demand <input type="checkbox"/> Other <u>Return</u> TRADEMARKS: <input type="checkbox"/> Transmittal Letter <input type="checkbox"/> ITU Application <input type="checkbox"/> TM/SM Application w/specimens <input type="checkbox"/> Request for Extension of Time <input type="checkbox"/> Amendment/Response <input type="checkbox"/> Statement of Use with 3 specimens <input type="checkbox"/> Amendment to Allege Use <input type="checkbox"/> Sec. 8 & 15 Affidavits <input type="checkbox"/> Renewal Application <input type="checkbox"/> Other
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7866 130.00

☐ Deposit Account
☒ Certificate of Mailing

☐ Check No. 6 for \$ 130.00
☐ Certificate of Express Mail

Correction of these papers (the check and the acknowledgment postcard) is neither required nor expected, but is noted for the record.

Docket No. 12969

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler

Serial No.: ~~09/308,377~~Filing Date: ~~09/17/00~~

09/810,920

03/16/2001

Group Art Unit: 1714

Examiner: Szekely, P.

Title: Polymeric Thickeners for Oil-Containing Compositions

Mail Stop AF

Commissioner for Patents

Attention Petitions Branch

P.O. Box 1450

Alexandria, VA 22313-1450

PETITION

Sir,

This is a petition to the Commissioner

- (1) to direct the Examiner to withdraw the finality of the Office Action mailed October 10, 2003, on the ground that a clear issue for appeal has not been developed, and
- (2) insofar as the Commissioner deems it appropriate, to direct the Examiner to provide reasoned answers to the Applicants' arguments.

Background

On June 17, 2003, Applicants mailed a Petition to direct the Examiner as to the Correct Construction of the Claims. On October 7, 2003, the Commissioner dismissed

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

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On December 10, 2003

Typed name of person signing this certificate: T. H. P. Richardson

Signature



(ii) Mueller's objective is to lower the pour point of an oil, which necessarily means that the oil is made thinner, whereas Morawsky's objective is to thicken an oil;

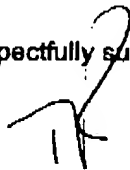
(iii) Mueller discloses a preferred range of 0.005 to 0.2% for the concentration of additive, and in fact uses, in the specific Examples, 0.04 to 0.1%; and Morawsky discloses a preferred range of 0.5 to 10%, and in fact uses, in the specific Examples 5%, so that there is no overlap between the concentration ranges in which Mueller and Morawsky achieved practical results.

The Final Rejection does not comment on these arguments.

4. The rejection of claim 6 under 35 USC 103

On page 22, lines 26-31 of the attached Reply, it was noted that claims 6 and 7 had been rejected under 35 USC 102 and that claim 6 (but not claim 7) had been rejected under 35 USC 103; that those claims require the presence of hydroxyl groups in the SCC polymer additive; that there is nothing in Mueller to suggest the use of hydroxyl-containing SCC polymers; and that the office action says nothing about this difference. In the outstanding Final Rejection, claims 6 and 7 are no longer rejected under 35 USC 102, but claim 6 remains rejected under 35 USC 103, without any reasons given for the rejection.

Respectfully submitted,



T. H. P. Richardson,
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